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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/025,065
Filing Date: December 19, 2001
Appellant(s): LANZENDORFER ET AL.

William C. Gerstenzang
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 12, 2005 appealing from the Office action mailed January 11, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 6,489,395	Loffler	09-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loffler (US 6489395). This rejection is set forth in the prior Office Action mailed January 11, 2005, and reiterated in full below.

Loffler discloses cosmetic emulsion compositions for skin care, an oil-in-water system, comprising from 69.10-81.90 % water, 5-20% lipid phase such as Jojoba oil and mineral oil, 0.1-5% of oligoester emulsifiers which may be up to 10%, and Aristoflex AVC (ammonium acryloyldimethyltaurates/vinylpyrrolidone copolymer) in amount of 0.6-0.7 % wt (see specific Examples 1-7 at col.5-7).

Loffler does not expressly disclose a particular composition comprising the particular amounts of ingredients, e.g. 0.2 to 0.3% of Aristoflex AVC.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize and determine the particular amount of Aristoflex AVC in the compositions, e.g. 0.2 to 0.3% of Aristoflex AVC.

One having ordinary skill in the art at the time the invention was made would have been motivated to optimize and determine the particular amounts of ingredients in the compositions, e.g. 0.2 to 0.3% of Aristoflex AVC, since the compositions of Loffler

for the same intended use, skin caring, comprising the same ingredients, water phase, lipid phase, and emulsifiers in the same amounts as the instantly claimed, and Aristoflex AVC (ammonium acryloyldimethyltaurates/vinylpyrrolidone copolymer) in amount of 0.6 - 0.7 % wt which is substantially close to 0.2 to 0.3% wt as claimed herein.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Moreover, the optimization of the amounts which is close to the known amount according the disclosures of Loffler is considered well within conventional skills in cosmetic science, involving merely routine skill in the art.

Claims 4-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loffler (US 6489395) in view of Applicant's admission regarding the prior art in the specification at page 14-19. This rejection is set forth in the prior Office Action mailed January 11, 2005, and reiterated in full below.

The same disclosure of Loffler has been discussed in the 103(a) rejection set forth above (see supra).

Loffler does not expressly disclose the compositions therein further comprising one or more dyes coloring pigments.

It is noted that Applicant cites the general teaching in regard to adding dyes coloring pigments or cosmetic colorants into a cosmetic composition, from the Book, the Rowe Colour Index, 3rd Edition, Society of Dyers and Coloudsts, Bradford, England,

1971. See Applicant's admission regarding the prior art in the specification at page 14-19.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to further comprise one or more dyes coloring pigments in the compositions.

One having ordinary skill in the art at the time the invention was made would have been motivated to further comprise one or more dyes coloring pigments in the known compositions since adding dyes coloring pigments to a cosmetic composition is well known in the art and is considered conventional in the competence level of an ordinary skilled artisan in cosmetic science.

(10) Response to Argument

Claim Rejections - 35 USC § 103 Maintained

Claims 1, 3, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loffler (US 6489395) reiterated in full above.

It is the examiner's position that the present invention is clearly obvious in view of the prior art of record, as discussed below.

Appellant primarily argues that:

"The description is totally silent that acryloyldimethyltaurates/vinylpyrrolidone copolymer copolymer (Aristoflex AVC). In the face of this void, there is absolutely no teaching or suggestion to reduce the amount to 0.2-0.3%. For there to be such a suggestion, there would have to at least be some disclosure of the reasons *why* Aristoflex was included in the first place, or of what it does. No one would be motivated to "select optimum parameters...to achieve a beneficial

effect". "No person reading Loffler would have any idea of what the Aristoflex AVC does in his compositions, and would cedainly have no reason to vary his amounts. There is absolutely no suggestion to reduce Loffler's amounts to the specific levels claimed by Appellants. One cannot "optimize" something if one does not know what it is that is to be optimized!"

Appellant's argument is not found persuasive, since first, note that the instant specification merely discloses that the emulsion composition herein comprising up to 5% by weight of one or more ammonium acryloyldimethyltaurates/vinylpyrrolidone copolymers (Aristoflex AVC) (see page 2 line 25-26),

Note that the amount of Aristoflex AVC, in the cosmetic emulsion compositions disclosed by Loffler is 0.6-0.7 % wt. Thus, the amount disclosed by Loffler, reads on up to 5% wt (which is 0-5% wt) disclosed in the specification herein.

Note that the specification herein does not describe or explain why the amount of these copolymers in the claimed composition has to be up to 5% by weight, and *what* is the criticality and significance of the claimed composition associated with these copolymers having the amount up to 5% by weight. Most importantly, the instant specification **fails** to explain *why* the amount of these copolymers in the claimed emulsion composition has now been reduced to 0.2 to 0.3% by weight from up to 5% wt, and what the beneficial effect or critical property does result from this change.

In such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range." In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir.1990). See also MPEP § 716.02 - § 716.02(g) for a discussion of criticality and unexpected results.

The record contains no such clear and convincing factual evidence of nonobviousness or unexpected results, i.e., side-by-side comparison with the closest prior art in support of nonobviousness for the instant claimed invention over the prior art.

Secondly, note that the utility of the claimed cosmetic or dermatological composition is for skin care in the cosmetics sense, to strengthen or restore the skin's natural function as a barrier against environmental influences and against the loss of endogenous substances (e.g. water, natural fats, electrolytes) (see page 1 line 21-25 of the specification herein).

Thus, Loffler discloses the same utility for cosmetic emulsion compositions therein as claimed herein, for skin care: day creams, night creams, care creams, nourishing creams, body lotions, ointment, Sun protection milk (see col.4 line 20-25; particular examples at col.5-7).

Hence, one of ordinary skill in the art would recognize that the compositions of Loffler and Appellant's claimed compositions herein would have same or substantial same properties for the same use.

It is noted that arguments of counsel cannot take the place of factually supported objective evidence. See, e.g., In re Huang, 100 F.3d 135,139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996); In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

For the rejection of Claims 4-5 and 7-8 made under 35 U.S.C. 103(a) as being unpatentable over Loffler (US 6489395) in view of Applicant's admission regarding the prior art in the specification at page 14-19, note that Appellant did not argue the well

known practice in cosmetic art, adding dyes coloring pigments or cosmetic colorants into a cosmetic composition, but maintain the argument for Loffler.

Thus, for the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees

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Primary Examiner
October 24, 2005

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